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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,866	08/29/2001	Kazuyuki Hayashi	1417-360	5095

23117 7590 09/07/2004  
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EXAMINER

WYROZEBSKI LEE, KATARZYNA I

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/940,866

Applicant(s)

HAYASHI ET AL.

Examiner

Katarzyna Wyrozewski

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 56-116 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 56-116 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

In view of applicant's response and amendment dated 6/24/2004, examiner acknowledges cancellation of claims 1-55 and 58-60. Properly filed terminal disclaimer obviates double patenting rejection of record. Previously objected claims 56 and 57 have been re-written in independent form claiming rubber or resin composition comprising composite particle of cancelled claim 1. New claims 61-116 are added. Claims 61-115 directed to rubber or resin composition comprising colorant as previously described in cancelled claims with independent claims 71, 80, 87, 99 and 107. Claim 56 was directed towards inorganic white particles, whereas the newly added claims 107 refers to any type of pigment, which is broader claim. Claim 116 is pigment dispersion, which is still rejectable over the prior art record.

Second non-final office action is necessitated in view of the prior art that will be used to reject previously objected claims.

***Claim Rejections - 35 USC § 102***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 116 is rejected under 35 U.S.C. 102(b) as being anticipated by WINNIK (US 5,378,574).

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The discussion of the disclosure of WINNIK from paragraph 6 of the office action mailed on 1/28/2004 is incorporated here by reference.

*Claim Rejections - 35 USC § 103*

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 56-116 are rejected under 35 U.S.C. 103(a) as being unpatentable over WINNIK (US 5,378,574) in view of JP (01138114) and TUNASHIMA (US 6,126,915).

The discussion of the disclosure of WINNIK and TUNASHIMA from paragraph 6 and 10 of the office action mailed on 1/28/2004 is incorporated here by reference.

The difference between the present invention and the disclosure of the prior art of WINNIK is showing that the colored silica can be utilized in other composition such as coloring agent for synthetic resins.

With respect to the above argument, JP prior art discloses colored silica that is utilized as a filler for synthetic rubber or a coloring agent for paints and synthetic resin (see attached Abstract).

Silica is well known reinforcing filler for rubber composition, for example, for tires. It is also known pigment.

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In the light of the above disclosure, it would have been obvious to one having ordinary skill in the art at the time of the instant invention to utilize the silica of WINNIK in other compositions such as those involving rubber and resin. Selection of a known material based on its suitability for its intended use supports *prima facie* obviousness. *Sinclair & Carroll Co vs. Interchemical Corp.* 325 U.S. 327, 65 USPQ 297 (1945).

5. Applicant's arguments are considered moot, due to changes in the prior art as applied against present claims.

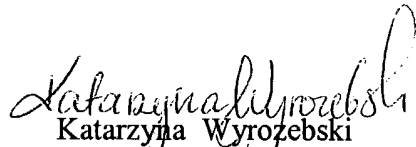
6. The examiner acknowledges receipt of most of the prior art documents either in the present invention or in the CIP. The applicants should however, submit certified copies of all priority documents with the parent application. In addition the applicants are still missing JP 2002-59439.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski whose telephone number is (571) 272-1127. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Katarzyna Wyrozebski  
Primary Examiner  
Art Unit 1714

September 3, 2004